

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

REMARKS

Applicants thanks the Patent Office for acknowledging Applicants' claim to foreign priority, and for indicating that the certified copy of the priority document, Korean Patent Application No. 00-33579 dated June 19, 2000, has been made of record in the file.

Applicants thank the Patent Office for initialing the references listed on the PTO/SB/08 A & B form submitted with the Information Disclosure Statement filed on December 5, 2003, thereby confirming that the listed references have been considered.

Claims 1-42 have been examined on their merits.

Applicants herein cancel claim 21 without prejudice and/or disclaimer.

Applicants herein editorially amend claims 1, 3, 4, 6-10, 14-19, 22-28, 36, 39 and 40 for reasons of precision of language. The amendments to claims 1, 3, 4, 6-10, 14-19, 22-28, 36, 39 and 40 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 1, 3, 4, 6-10, 14-19, 22-28, 36, 39 and 40 were not made for reasons of patentability under 35 U.S.C. § 102, 35 U.S.C. § 103 and/or 35 U.S.C. § 112.

Claims 1-20 and 22-42 are all the claims presently pending in the application.

1. Claims 1 and 4 stand objected to as containing informalities. Applicants herein amend claims 1 and 4 to remove the informalities, and request that the Patent Office withdraw the objection to claim 1 and 4. The amendments to claims 1 and 4 were made merely to more

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accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 1 and 4 were not made for reasons of patentability under 35 U.S.C. § 102, 35 U.S.C. § 103 and/or 35 U.S.C. § 112.

2. Claims 7, 9, 13, 15, 17, 21, 23, 25-27, 33-35, 37 and 38 stand objected to under 37 C.F.R. § 1.75 as allegedly being substantial duplicates of claims 6, 8, 12, 14, 16, 20, 22, 24, 32 and 36, respectively. The objection to claim 21 is now moot due to its cancellation. Applicants traverse the objection of claims 7, 9, 13, 15, 17, 23, 25-27, 33-35, 37 and 38 for at least the reasons discussed below.

As noted in MPEP § 706.03(k), a “mere difference in scope between claims has been held to be enough.” A 37 C.F.R. § 1.75 objection to duplicative claiming is proper only when two claims in an application “are duplicates, or the claims are so close in content that they both cover the same thing, despite a slight difference in wording.” *Id.*

Claims 7 and 9 have different recitations than claims 6 and 8, respectively, in that specific types of trading points are recited in claims 7 and 9, whereas claims 6 and 8 have no such recitation. Applicants submit that the 37 C.F.R. § 1.75 objection to claims 7 and 9 is unfounded, and respectfully request withdrawal of same. If the Patent Office maintains the objection to claims 7 and 9, Applicants request that the Patent Office provide detailed reasoning (including supporting case law) as to why claims 7 and 9 are duplicates or close in content to claims 6 and 8.

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Claims 13, 15 and 17 have different recitations than claims 12, 14 and 16, respectively, in that specific types of trading points are recited in claims 13, 15 and 17, whereas claims 12, 14 and 16 have no such recitation. Applicants submit that the 37 C.F.R. § 1.75 objection to claims 13, 15 and 17 is unfounded, and respectfully request withdrawal of same. If the Patent Office maintains the objection to claims 13, 15 and 17, Applicants request that the Patent Office provide detailed reasoning (including supporting case law) as to why claims 13, 15 and 17 are duplicates or close in content to claims 12, 14 and 16.

Claims 23, 25 and 27 have different recitations than claims 22, 24 and 26, respectively, in that sending information regarding a customer's trading points and transaction exchange rates stored in a database are recited in claims 23, 25 and 27, whereas claims 22, 24 and 26 have no such recitation. Applicants submit that the 37 C.F.R. § 1.75 objection to claims 23, 25 and 27 is unfounded, and respectfully request withdrawal of same. If the Patent Office maintains the objection to claims 23, 25 and 27, Applicants request that the Patent Office provide detailed reasoning (including supporting case law) as to why claims 23, 25 and 27 are duplicates or close in content to claims 22, 24 and 26.

Claims 33, 35 and 37 have different recitations than claims 32, 34 and 36, respectively. Applicants submit that the 37 C.F.R. § 1.75 objection to claims 33, 35 and 37 is unfounded, and respectfully request withdrawal of same. If the Patent Office maintains the objection to claims 33, 35 and 37, Applicants request that the Patent Office provide detailed reasoning (including supporting case law) as to why claims 33, 35 and 37 are duplicates or close in content to claims 32, 34 and 36.

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3. Claims 4-9, 10-17 and 18-27 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The rejection of claim 21 is now moot due to its cancellation. Applicants traverse the rejection of claims 4-6, 8, 10-20 and 21-27 for at least the reasons discussed below.

Applicants have amended the preamble of independent claim 4 to recite a method for trading points via a telecommunication network. Applicants submit that claim 4 is now allowable, and further submit that claims 5-9 are allowable as well, at least by virtue of their dependency from claim 4. Applicants respectfully request that the Patent Office withdraw the § 101 rejection of claims 4-9.

Applicants have amended the preamble of independent claim 10 to recite a method for trading points via a telecommunication network. Applicants submit that claim 10 is now allowable, and further submit that claims 11-16 are allowable as well, at least by virtue of their dependency from claim 10. Applicants respectfully request that the Patent Office withdraw the § 101 rejection of claims 10-16.

Applicants have amended the preamble of independent claim 18 to recite a method for trading points via a telecommunication network. Applicants submit that claim 18 is now allowable, and further submit that claims 19, 20 and 22-27 are allowable as well, at least by virtue of their dependency from claim 18. Applicants respectfully request that the Patent Office withdraw the § 101 rejection of claims 18-20 and 22-27.

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4. Claims 1-5, 8-13, 16, 17 and 28-42 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Postrel (U.S. Patent No. 6,594,640). Applicants traverse the rejection of claims 1-5, 8-13, 16, 17 and 28-42 at least for the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Postrel fails to teach or suggest receiving a request to trade the trading points awarded to one customer with at least one other customer, as recited in claim 1. One portion of Postrel cited by the Patent Office is directed to a customer's purchase of points already traded in by another customer to a manufacturer or reseller of goods or services ("allow for purchase by users of points *traded in* by other users" col. 1, lines 23-24 of Postrel). Another portion of Postrel cited by the Patent Office is directed to the repurchase of reward points by the *issuers* of the reward points. See col. 5, lines 61-66 of Postrel. In that cited passage, an exchange of trading points between two customers of a member manufacturer or reseller of goods or services is not

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disclosed or contemplated. In either cited passage, the trading of points between customers of a member shop is neither taught nor suggested.

Based on the foregoing reasons, Applicants submit that Postrel fails to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Postrel clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claim 2 and 3 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 1-3.

With respect to independent claim 4, Applicants submit that claim 4 is allowable for at least the same reasons discussed above with respect to Postrel, in that Postrel fails to teach or suggest receiving a request to trade the trading points awarded to one customer with at least one other customer. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 4 is allowable, and further submit that claims 5, 8 and 9 are allowable as well, at least by virtue of their dependency from claim 4. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 4, 5, 8 and 9.

With respect to independent claim 10, Applicants submit that claim 10 is allowable for at least the same reasons discussed above with respect to Postrel, in that Postrel fails to teach or suggest receiving a request to trade the trading points awarded to one customer with at least one other customer. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 10 is allowable, and further submit that claims 11-13, 16 and 17 are allowable as well, at least by

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virtue of their dependency from claim 10. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 10-13, 16 and 17.

With respect to independent claim 28, Applicants submit that claim 28 is allowable for at least the same reasons discussed above with respect to Postrel, in that Postrel fails to teach or suggest receiving a request to trade the trading points awarded to one customer with at least one other customer. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 28 is allowable, and further submit that claims 29-37 are allowable as well, at least by virtue of their dependency from claim 28. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 28-37.

With respect to independent claim 39, Applicants submit that claim 39 is allowable for at least the same reasons discussed above with respect to Postrel, in that Postrel fails to teach or suggest receiving a request to trade the trading points awarded to one customer with at least one other customer. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 39 is allowable, and respectfully request that the Patent Office withdraw the § 102(e) rejection of claim 39.

With respect to independent claim 40, Applicants submit that claim 40 is allowable for at least the same reasons discussed above with respect to Postrel, in that Postrel fails to teach or suggest receiving a request to trade the trading points awarded to one customer with at least one other customer. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 40 is allowable, and further submit that claims 41 and 42 are allowable as well, at least by virtue of

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their dependency from claim 40. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 40-42.

5. Claims 6, 7, 14, 15 and 18-27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Postrel. The rejection of claim 21 is now moot due to its cancellation. Applicants traverse the rejection of claims 6, 7, 14, 15, 18-20 and 22-27 at least for the reasons discussed below.

With respect to claims 6 and 7, the Patent Office alleges that it would have been obvious to one of ordinary skill in the art to record the transaction and to notify the member shop. However, Postrel still fails to teach or suggest receiving a request to trade the trading points awarded to one customer with at least one other customer, as recited in claim 4 and included via dependency in claims 6 and 7. One portion of Postrel cited by the Patent Office is directed to a customer's purchase of points already traded in by another customer to a manufacturer or reseller of goods or services ("allow for purchase by users of points *traded in* by other users" col. 1, lines 23-24 of Postrel). Another portion of Postrel cited by the Patent Office is directed to the repurchase of reward points by the *issuers* of the reward points. *See* col. 5, lines 61-66 of Postrel. In that cited passage, an exchange of trading points between two customers of a member manufacturer or reseller of goods or services is not disclosed or contemplated. In either cited passage, the trading of points between customers of a member shop is neither taught nor suggested. Thus, Applicants submit that the Patent Office cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

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Since Postrel fails to disclose the exchange of trading points between customers of a member shop, Applicants submit that one of skill in the art would not be motivated to modify the reference. Although the Patent Office provides a motivation analysis with respect to recording a “paper trail”, Postrel lacks any disclosure with respect to the exchange of trading points between customers of a member shop. Since there is no exchange of trading points between customers, then there can be no motivation to record the transaction and notify the member shop. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembicza*k and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that Postrel fails to disclose all of the claimed elements as arranged in claim 4, and included via dependency in claims 6 and 7. Therefore, Postrel clearly cannot render the present invention obvious as recited in claims 6 and 7. Thus, Applicants submit that claims 6 and 7 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 6 and 7.

With respect to claims 14 and 15, Applicants submit that claims 14 and 15 are allowable for at least the same reasons discussed above with respect to claims 6 and 7, in that Postrel fails to teach or suggest the exchange of trading points between customers of a member shop. Thus, Applicants submit that claims 14 and 15 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 14 and 15.

With respect to claims 18-20 and 22-27, Applicants submit that claims 18-20 and 22-27 are allowable for at least the same reasons discussed above with respect to claims 6 and 7, in that Postrel fails to teach or suggest the exchange of trading points between customers of a member

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shop. Thus, Applicants submit that claims 18-20 and 22-27 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 18-20 and 22-27.

6. Claims 1, 2 and 4-7 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kimberly Weisul “Web Brokers Lure Clients With Premiums” (hereinafter “Weisul”) in view of Postrel. Applicants traverse the rejection of claims 1, 2 and 4-7 for at least the reasons discussed below.

The Patent Office expressly acknowledges that Weisul fails to teach or suggest collecting information regarding a customer’s trading points portfolio and storing the information in a customer database. The Patent Office alleges that Postrel provides the necessary disclosure to overcome the acknowledged deficiencies of Weisul.

The combination of Weisul and Postrel fails to teach or suggest receiving a request to trade the trading points awarded to one customer with at least one other customer, as recited in claim 1. The deficiencies of Postrel with respect to exchanging trading points between customers of a member shop has been discussed above, and Applicants herein incorporate by reference that discussion. Contrary to the Patent Office’s allegations, Weisul nowhere states that trading points can be traded between customers of a member shop.¹ Since the combination of Weisul and Postrel is, at best, directed to a method and system for exchanging reward points between a customer and a member shop, and not between individual customers of a member

¹ Ambiguities in the cited art must be construed against the Examiner. *In re Robinson*, 49 U.S.P.Q.2d 1949, 1951 (Fed. Cir. 1999).

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shop, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*. Finally, since neither reference teaches or suggests the exchange of trading points between customers of a member shop based on a trading request, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembicza*k and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Weisul and Postrel fails to disclose all of the claimed elements as arranged in claim 1. Therefore, the combination of Weisul and Postrel clearly cannot render the present invention obvious as recited in claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claim 2 is allowable as well. Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 1 and 2.

With respect to claims 4-7, Applicants submit that claims 4-7 are allowable for at least the same reasons discussed above with respect to claim 1, in that the combination of Weisul and Postrel fails to teach or suggest the exchange of trading points between customers of a member shop. Thus, Applicants submit that claims 4-7 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 4-7.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE
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